

**REMARKS****I. Rejection under 35 U.S.C. § 101**

The Examiner rejected Claims 1 and 29 under 35 U.S.C. § 101. Applicant has amended these claims in a way that addresses the Examiner's concerns. In particular, claims 1 and 29 have been amended to recite technology within the body of the claim in a non-trivial matter. Claim 1 now recites "in the computer system, for each of a plurality of examined auctions..." and in the computer system, for each of the distinguished auctions...." Likewise, claim 29 now recites "in the computer system, identifying a second user..." and "in the computer system, promoting the first auction to the second user...."

As amended, claims 1 and 29 are more clearly connected to the technological arts, and therefore constitute statutory subject matter under 35 U.S.C. § 101. Accordingly, applicant respectfully requests that the rejection be withdrawn.

**II. Rejection under 35 U.S.C. § 103**

Claims 1-8, 29, and 30 are rejected under 35 U.S.C. § 103 as being unpatentable over an August 9, 1986 National Underwriter article entitled "U.S. and U.K. Execs View the Marketing Arena" (the "Marketing Article") in view of Ortega et al. (US 6,549,905) ("Ortega"). Applicant respectfully traverses these rejections.

**A. *Applicant's Claimed Embodiments***

An auction having a large pool of bidders tends to result in a higher ending sale price than an auction having a smaller pool of bidders. (See Specification at page 1, lines 23 and 24.) Accordingly, applicant's rejected claims are directed to identifying potential bidders for a particular auction, so that the auction can be promoted to those individual bidders in order to maximize the number of bidders in the auction. However, applicant's claimed embodiments do not simply identify potential bidders at random. Rather,

applicant's claims 1, 5, 29, and 30 provide for a specific set of actions to be taken to identify such users--actions which are not disclosed anywhere in the applied references.

*B. The Applied References*

The Marketing Article describes specific targeted marketing practices, including the following: (1) using a five-component database to "target specific households for specific product offers;" (2) including, in the five-component database, household information, customer information, account summary information, promotion information, and purchase history; (3) marketing to "current customers," "former customers," and "prospects."

While the Marketing Article specifies that certain broadly-defined groups of customers will be marketed to, other than relying on a marketing database to target users, it does not provide any description or detail about how users within such groups will be specifically identified.

The Ortega reference is directed to generating notification of auctions based on user notification requests. Accordingly, the Ortega reference also fails to disclose applicant's claimed embodiments for identifying specific users who will be marketed to.

*C. Claims 1 and 5*

Claims 1 and 5 recite "identifying users to whom to promote a selected auction," or similar language. Claims 1 and 5 also recite various claim features associated with "examined auctions," which are a set of auctions that are distinct from the selected auction. In particular, for each of the examined auctions, a determination is made as to whether the auction should be considered a "distinguished auction." A "distinguished auction" is one where the number of users that have bid in the selected auction that also bid in the examined auction exceeds a minimum threshold. Claims 1 and 5 conclude by reciting "for each of the distinguished auctions, identifying users that bid in the distinguished auction and did not bid in the selected auction," or similar language.

None of the applied references discloses applicant's selected auction, applicant's examined auctions, applicant's distinguished auctions, or any of the claim features of claims 1 and 5 that are associated with these auction types. Yet, it is the Examiner's burden to point to any such similarities to establish a *prima facie* case of obviousness; merely asserting that the practice of "marketing sales events, goods, and services to former customers who are not currently active and who have been active or related to the business entity previously" is analogous to applicant's specifically claimed embodiments involving examining and distinguishing auctions is not sufficient to support an obviousness rejection. Because the applied references do not disclose or clearly suggest every element of each of applicant's claims, an obviousness rejection is inappropriate. Accordingly, applicant respectfully requests that the rejections of claims 1, 5, and their dependent claims be withdrawn.

*D. Claims 29 and 30*

Also relating to auctions, claim 29 recites "identifying a second user that has not bid in the first auction and that has bid in a second auction in which the first user has bid" and "promoting the first auction to the second user." Claim 30 recites similar language, including "a user identification subsystem adapted to identify a second user that has not bid in the first auction and that has bid in a second auction in which the first user has bid" and an "auction promotion subsystem adapted to promote the first auction to the second user."

None of the applied references discloses applicant's claimed embodiments of promoting auctions. Yet, it is the Examiner's burden to point to any such similarities to establish a *prima facie* case of obviousness. While Ortega discusses auctions, there is no reference to promoting auctions. Additionally, the marketing techniques disclosed in the Marketing Article do not relate to auctions, and certainly do not involve "identifying a second user that has not bid in the first auction and that has bid in a second auction in which the first user has bid." Rather, the Marketing Article discusses only general

marketing strategies (i.e., marketing to current, past, and prospective customers using a five-element database).

In addition, because the Marketing Article deals with non-auction sales, it actually teaches away from applicant's claimed embodiments because customers that bid in an auction (but did not necessarily win the auction) are not the same as customers that have actually purchased a product or service in the past. Even if customers that buy goods and services in a non-auction context can be compared with auction bidders (a comparison that applicant does not agree with), unlike applicant's claims, the Marketing Article simply does not provide any mention of how specific customers would be selected from a larger pool consisting of all current, past, and prospective customers. Instead, the Marketing Article seems to imply that all customers in the customer base will eventually be targeted (with the current customers being targeted before the former customers, and the prospective customers being targeted last). Because the applied references do not disclose or clearly suggest every element of each of applicant's claims, an obviousness rejection is inappropriate. Accordingly, applicant respectfully requests that the rejections of claims 29 and 30 be withdrawn.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0665, under Order No. 249768028US1 from which the undersigned is authorized to draw.

Dated: 8/29/05

Respectfully submitted,

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